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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/787,326	06/05/2001	David Palmowski	P/3298-14	9476

2352 7590 10/06/2003

OSTROLENK FABER GERB & SOFFEN  
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NEW YORK, NY 100368403

EXAMINER
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SHANLEY, DANIEL G

ART UNIT	PAPER NUMBER
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3723

DATE MAILED: 10/06/2003

11

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Applicati n No.

09/787,326

Applicant(s)

PALMOWSKI ET AL.

Examiner

Daniel G. Shanley

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-- Th MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on the election filed on 7/28/03.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-53 and 55-72 is/are pending in the application.
- 4a) Of the above claim(s) 1-39 and 55 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) 40-53 and 56-72 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

**DETAILED ACTION**

***Election/Restrictions***

Applicant's election without traverse of claims 1-53 and 56-72 in Paper No. 10 is acknowledged.

***Claim Objections***

Claims 47, 49, 50, 52 and 59-61 are objected to because of the following informalities: The use of dashes to set apart limitations is not in accordance with standard practice. Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 40, 47-49, 51-53, and 63-65 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

- 1) Specifically, claims 47-49, 51-53, and 63-65 are dependent on non-elected claim 1 from the preliminary amendment. Is the dependency of these claims correct? The preliminary amendment and subsequent election of species are contradictory and unclear to the examiner.
- 2) Claim 40, line 4, what element further contains a drive? The element containing a drive is inferentially claimed.

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- 3) Claim 41, line 2, the phrase "may be adjusted manually or by a drive" is not fully understood by the examiner. Is this drive different then the two previous drives recited in claim 40?
- 4) Claim 45 is not fully understood. If claim 44 state that one storage device must be mechanical, then claim 44 states that the stripping length is electrical, then by default the stripping depth has to be mechanical and not one of mechanical, electrical, or a combination. Claim 45 is unclear to the examiner in light of claim 44.
- 5) Claim 49, the phrase "preferably" is not fully understood by the examiner.
- 6) Claim 50, line 6, the phrase "for to control" is not fully understood.
- 7) Claim 56, line 4, "a novel adjuster" is not fully understood. Moreover, item c) Omits an article prior to the structural element.
- 8) Claim 66, items a)-f) omit articles prior to the structural elements.
- 9) Claim 69, the term "signalising" should be spelled "signalizing."

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 40-46, 50, 56-62, and 66-72 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-25 of U.S. Patent No. 6,176,155. Although the conflicting claims are not identical, they are not patentably distinct from each other because a wire stripping apparatus having a cutter and cutter drive with a system for manually adjusting and mechanically or electrically storing a plurality of depth and length values corresponding to the depth/length of the cuts is disclosed.

For example, claims 40 and 50, though using different claim language, disclose a clamp and blade moved relatively towards and away from one another during the time when a wire is clamped, further containing a drive for moving the blade radially with respect to the wire and away from the wire; characterized in that between the blade and the drive or parallel to the blade and the drive a mechanical depth information storage with at least two different storage depths is provided and propelled by the same or a different drive when the cutting blade is set. Claims 41-43 add a scale and a storage for providing stripping length and a second storage for providing a depth. Claim 1 of US 6,176, 155 discloses a storage system for storing a plurality of values, a turret drive for moving the blades toward a fixed, forward and rear position. The claims do not specifically disclose a drive for moving the blade away from the wire, however, it flows naturally from the language that the blade must disengage from the wire at some point. Furthermore, it would have been obvious to add a scale or screen for viewing storage values (as disclosed in claim 23).

Next, claims 44-46 discuss the combination of an electronic and mechanical storage means. Claim 1 and 10 of US 6,176, 155 disclose the individual use of an electronic and a mechanical storage means. Therefore, it would have been obvious to one having ordinary skill in the art to combine the two storage means.

Moreover, claims 56-62, disclose the use of a stepper motor, an indexer, and sequential moving means. It would have been obvious to combine the limitations of claims 1, 6, 9 and 11 to meet the limitations of claims 56-62.

Claim 64 is obvious in light of claim 20 step e) of the patented case.

Claim 65 is obvious in light of claim 12 of the patented case.

Lastly, claims 66-72 are obvious variations of the previously disclosed claims discussed above.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Konen, Stepan, and Hsieh disclose wire strippers.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel G. Shanley whose telephone number is 703-305-0306. The examiner can normally be reached on M-F 0830-1700.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Hail can be reached on 703-308-2687. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9302 for regular communications and 703-872-9303 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1148.

A handwritten signature in black ink, appearing to read "Joseph J. Hail, III", with a stylized flourish at the end.

Joseph J. Hail, III  
Supervisory Patent Examiner  
Technology Center 3700

DGS  
September 30, 2003